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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1941.

TERNSTEDT MANUFACTURING COMPANY and GENERAL MOTORS CORPORATION,
Petitioners,

vs.

MOTOR PRODUCTS CORPORATION,
Respondent.

No. 652.

PETITION FOR WRIT OF CERTIORARI

To the United States Circuit Court of Appeals for the Sixth Circuit.

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PETITION FOR WRIT OF CERTIORARI

To the United States Circuit Court of Appeals for the Sixth Circuit.

To the Honorable Chief Justice of the United States, and the Associated Justices of the Supreme Court of the United States:

Your petitioners, Ternstedt Manufacturing Company and General Motors Corporation, pray for a Writ of Certiorari to the Circuit Court of Appeals for the Sixth Circuit to review the judgment of that court entered June 25th, 1941.

SUMMARY AND SHORT STATEMENT.

Petitioners were plaintiffs in the District Court, in an equity suit for infringement of two patents, namely, the **Wright** reissue patent Re. No. 18,866 granted June 13, 1933, and the Fisher patent No. 2,048,605 granted June 21, 1936. The suit involved certain claims of the Wright patent and all of the claims of the Fisher patent. The District Court held (R. 767) all the claims in issue of the Wright and Fisher patents invalid over prior patents, printed publications and an alleged prior use; the Wright patent "because of anticipation and lack of invention" and the Fisher patent "for lack of invention"; however, the District Court held that each of the patents **"if valid over the prior art would be infringed by each of the accused devices."** A judgment (R. 768) was entered dismissing the complaint, supplemented by Findings of Fact and Conclusions of Law (R. 756-767).

The Circuit Court of Appeals for the Sixth Circuit affirmed the Judgment of the District Court by its decision of June 25, 1941 (R. ...) and its mandate issued on June 25, 1941 (R. ...). The Appeals Court's decision, while affirming the Decree of the District Court, discussed specifically only the question of validity. For convenience a copy of the decision is appended hereto.

The patents in suit have the relation of generic and improvement patents; the Wright patent (R. 794) being a generic patent and the Fisher patent (R. 806) an improvement on Wright, as found by the District Court (R. 758 and 760). The District Court found (R. 760):

> "The construction of the Fisher patent includes that of the Wright patent so that which would infringe the Fisher patent would also infringe the Wright patent."

Note: All emphasis in this Petition and in the Brief are ours.

In view of the above findings of the District Court with reference to the Fisher patent, as related to the Wright patent, **this Petition is only directed to the Wright patent** and it will be sufficient to limit consideration to claims 8 and 19 of the Wright patent.

Subject Matter.

The subject matter of the suit and embodying the invention of the Wright patent, as found by the District Court, involves the well-known **"No Draft Ventilation"** now used on practically every automobile. No Draft Ventilation became standard equipment on all of **General Motors** closed cars beginning in 1932 and has since been adopted as standard equipment on all automobiles in this country except the Lincoln, a custom-built car (R. 551). **Chrysler** Corporation first adopted the Wright invention for its entire line beginning with the production year of 1934, and although Chrysler then went partly to another system, namely, the Crowell system, for the lower priced Dodge and Plymouth cars, for the production years of 1935 and 1936, it retained the Wright invention in the higher priced De Soto and Chrysler cars. Beginning 1937 the Wright invention was again incorporated in the Dodge and Plymouth cars and has continued in all Chrysler Corporation cars ever since (R. 89-90). The **Ford** Motor Company continued the use of the Crowell system (R. 89) until the fall of 1939, when that company adopted the Wright invention for the entire Ford line except for the Lincoln, a custom-built car (R. 551). At the conclusion of the trial it, therefore, appeared that automobile manufacturers in this country had adopted the Wright invention practically **100 per cent.**

No Draft Ventilation embodying the improvement of the Wright patent, as employed in the closed cars of General Motors and other automobile companies, may be generally

described as follows: The front door of a closed car body, immediately behind a slanting windshield, has a window embodying two separate glass panels, one directly behind the other. The front panel is pivoted forwardly on a generally up and down axis so as to provide a substantial area of the panel to the rear of the pivot. The rear end of this front panel may be swung outwardly and held in any one of numerous positions from 0° to beyond 60° with respect to the side of the car. The rear panel slides down into a well in the door to open and slides up to close the rear part of the window; this panel is adjustable up and down by means of a window regulator, and may be held in any one of numerous positions. Enumerable combinations of adjustments of the swinging panel and of the sliding panel may therefore be had to give a variety of conditions affecting **controlled movement** of the air into and out of a closed car. An optimum condition may easily be achieved by the occupant of a car. There is such a pair of panels in each front door and each pair is capable of individual control.

The History of the Art shows that there was **a long-felt want** since the advent of the closed car, for a practical system of closed body ventilation, combined with a practical body construction, which was not solved until the advent of the Wright invention.* As the Court of Appeals found (Dec. p. 7):

> ". . . the ventilation of closed cars had the attention of body designers and automotive engineers from the first use of such cars."

While the Court of Appeals then says, "and the improvements in this respect were slow and steady," the fact is and as found by the District Court (Fd. 12, R. 761), there

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* Although the original Wright application was filed August 2, 1926, it did not issue until June 7, 1932, because of delay in the Patent Office, partly by an Interference proceeding. After issue it was purchased by petitioner and then reissued.

was no commercial use of any ventilating system of the character of the Wright patent before Wright filed.

That there was an immediate public demand for No Draft Ventilation in this country is established by the direct evidence in this case, namely, by data obtained by General Motors Customers Research, explained by Laseau (R. 239) and Exhibits 24-29 (R. 873-893). This Research shows that beginning with the year 1933, the year after No Draft Ventilation first appeared on General Motors cars, down to 1939, the demand for this system by owners of cars, including others than General Motors cars, was overwhelming.

No Draft Ventilation has not only completely revolutionized closed car ventilation, but closed car **body construction** as well. It has displaced entirely ventilation through the windshield, which was relied upon beginning with the advent of the closed car, but which was not only found ineffective, but permitted snow and rain to enter. The incorporation of the two panels in a door which extends up to the windshield makes possible, with improved ventilation and plenty of leg room, for the front seat occupants to easily enter and leave the car, the moving the driver's seat forward with the consequent increase in his field of vision, the shortening of the body, and improvement in the riding qualities of the car. This also makes possible a wide door with its advantages, without requiring a sliding glass panel so wide that operating mechanism for it becomes a problem.

It can truthfully be said that No Draft Ventilation is one of the most valuable improvements in automobile construction in the history of the automobile. If anyone questions this we will reply that nine years ago all closed cars had movable windshields and nothing but full width slideable windows; today every car has a fixed windshield, the front

seat is close to the windshield and the front door windows each embody a pivoted panel and a comparatively narrow vertical sliding panel, all as in the Wright patent. This construction has endured commercially without any material change for nearly a decade and for fifteen years after the filing of the Wright application.

* **The Accused Structures*** are practically copies of No Draft Ventilation as it first appeared in 1932. Indeed, any contention of noninfringement of the Wright patent is exceedingly technical and, as noted previously, the District Court found and concluded infringement of the Wright patent if valid.

The Parties. Petitioner, Ternstedt Manufacturing Company, is a subsidiary of petitioner, General Motors Corporation. Ternstedt manufactures the window frame assemblies for the ventilating system and these are built into the closed cars of General Motors; Ternstedt also supplies these frames to Nash Motor Company for Nash closed cars (R. 260-1). Respondent Motor Products Corporation occupies the same position in a competitive field as does Ternstedt, in that it also makes these window frame assemblies and supplies them to automobile companies for installation in closed cars (R. 85); examples of these are Chrysler and Hupp (R. 84) and lately the Willys Overland and the Ford Motor closed cars, except the Lincoln (R. 551). Chrysler Corporation is co-operating with respondent in the defense of this suit and appeared at the trial by its counsel (R. 476).

The Wright Patent.

In the specific embodiment of the Wright patent (R. 794, see illustration plaintiff's Ex. No. 1-C in Appendix), the

* Exhibits 4, 5, 6 and 7; illustrations in Record, pages 835, 841.

front panel W-23 is pivoted to the front door pillar adjacent the windshield, while in the commercial structures the front panel is pivoted on a generally up and down axis located somewhat rearwardly of its front edge. In Wright, as in the commercial structures, the front panel is **so constructed and pivoted that a substantially major portion of the panel is behind the axis**, and it can swing outwardly to 90 degrees (R. 796, line 22). The District Court found (R. 765-7) no patentable distinction in the above respect of the Fisher patent over the Wright patent, and specifically found that the **Wright patent is "not limited to the hinging of the front panel at the front edge** (R. 760). In the Wright patent as in the commercial structure, **the sliding panel**, W-18, adjacent and at the rear of the pivoted panel, moves into the door, **down to open and up to close** the window encompassed by that panel. Even the specific Wright structure has, however, gone into use in England (R. 228-230).

The Wright patent, therefore, involves a combination of elements in the front door of an automobile and immediately behind the windshield and comprising a pivoted front panel and a sliding rear panel of the construction described. **One of the essential features** of the Wright patent is that the front panel is constructed and pivoted in such a way as to permit the same to **move outwardly into the air stream** coming from around the windshield. **Another essential feature** of the Wright patent is that the sliding panel moves **down to open and up to close**, in order to properly co-operate with the pivoted panel so as to control the entrance and distribution of the air into and within the car and to secure as stated in the Wright patent (R. 796, line 66) **"adequate ventilation without objectionable drafts."**

It is important for the controlled operation of the system

of the Wright patent that the pivoted panel be so constructed, pivoted and movable as to extend into the air stream (R. 162); this is accomplished when the Wright panel is moved to 60° and beyond (R. 164). As shown in plaintiffs' Exhibit No. 1-E, reproduced in the Appendix, and as explained by Professor Thompson (R. 151-161), the air which impinges against the windshield is deflected away from the car body on both sides in curved or bowed-out paths, and does not return to the sides of the car until it gets some distance back of the windshield. If the sliding panel in the front door behind the windshield be moved down, to open then, absent control by the Wright principle, the air coming around the windshield will move through the window opening at a rather sharp angle, causing an objectionable draft. Control of this can be secured by manipulation of the Wright pivoted panel, which will deflect the air stream (1-E).

Additional control can be secured, when the pivoted panel is so extended, by manipulation of the **sliding panel**, as seen in the illustration No. 1-E, and as explained (R. 161-172, 47-48 and 707-710). In order, however, to effect this, the sliding panel must **move down to open and up to close**; for if it moves up to open there will immediately be a sharp blast over the "belt line," that is, the lower part of the window opening (R. 44 and 161).

By the happy combination of the Wright pivoted and sliding panels constructed and operating as described, on the Wright principle, innumerable conditions of ventilation may be secured, and there is definitely a combined result (R. 172) secured not by any single element, but by co-operation of these elements in a door at the front of the automobile and immediately behind the windshield.

In the Wright patent the door extends forwardly to the dash and adjacent the windshield. This is also advantage-

ous from a construction and a use standpoint (R. 693-4), for this has enabled the front seat to be placed close to the windshield, which attains the desirable results of increasing the field of vision of the driver, shortening the body, providing ample leg room, improving the riding qualities of the car and enabling a wide door to be used without an extremely wide sliding panel; all of this with improved ventilation.

The Prior Art.

The prior art relied upon comprises patents, magazine articles and an alleged Stafford car. The latter was not a commercial car, but one said to have been converted by its owner in 1924 by replacing the side curtains of a touring car with wood frame glass windows or sashes (C. C. A. Dec. p. 4), and only Stafford himself testified. Not a single commercial use of any prior patent or magazine article relied upon prior to Wright was proved or even attempted to be proved, although defendant had the co-operation of Chrysler Corporation. (See Fds. 12 and 16, R. 761, 763.)

With reference to the patents and magazine articles, defendant relied, in practically every case for disclosures of the Wright invention, upon drawings and in the case of magazine articles upon indefinite and faint drawings, perspective views and photograph cuts, supplemented by reading matter of from one to ten lines. However, even the most pertinent references, stated to be such by defendant's expert Mr. Brush (R. 351), namely, the **California Top** publication of the year 1922 (R. 1543) and a **Fennerty** Pullman car patent of the year 1886 (R. 1522), admittedly did not disclose either the Wright Pivoted panel or the Wright sliding panel, as will be seen from the blackboard exhibits 44 and 45 (R. 941 and 943); for admittedly the so-called pivoted panels of these references only swing out to 30°

or 40° (R. 351 and 354), which, however, Mr. Brush ascertained from the drawings alone. Professor Thompson showed (R. 163-4, 523) that such structures will not permit the pivoted panel to move out into the bowed-out air stream coming from behind the windshield to secure any useful controlling effect. Neither of these references has a sliding panel which moves down to open and up to close, and neither will secure the mode of operation of the Wright invention in that respect (R. 521, 524-5, 572, 725). In neither is the assembly in a door immediately behind the windshield to secure Wright's unproved body construction.

The Stafford car, discussed by the Court of Appeals (Dec. p. 4), admittedly did not have Wright's sliding panel (R. 471, 953). Professor Thompson showed that the Stafford centrally pivoted panel did not extend into the air stream and could have no useful controlling effect (R. 533, 534, 542, 544), while the sliding panel had the same vice as did that of the California Top (R. 532-4). The Gardner publication (C. C. A. Dec., p. 4) admittedly did not describe the structure of Wright's front pivoted panel at all (R. 385-7, 953). The Auburn wing (C. C. A. Dec., p. 4) admittedly did not describe the structure and Mr. Brush deduced everything from the drawing (R. 418), although Mr. Arnold found no pivoted wing at all (R. 694). The Anibal patent (Dec. p. 6) was found to have a "front panel stationary." The other prior art discussed by the Court of Appeals (Dec. pp. 4 and 5), except Fennerty, previously discussed, was subsequent to Wright's filing date in 1926, and was only used against Fisher.

No attempt was made by respondent to show by evidence of actual tests that any of the things relied upon by defendant had the principle or mode of operation or secured the results of the Wright combination. Although not incumbent upon petitioners to do so, their highly qualified

witnesses made extended tests to show that the Wright combination structure described in his patent attained in practice a new and distinctive principle and mode of operation and secured the results advanced, and that none of the things relied upon by respondent did so. All of this was graphically illustrated in Exhibit 66 (R. 1075) and explained by Professor Thompson (R. 578 etc.), and verified by the practical and experienced Arnold (R. 725). While these tests were made by these witnesses ex parte, near the conclusion of the trial, petitioners offered to repeat them interparties (R. 711). However, the District Court stated (R. 729), "I am satisfied that they made the tests and got the results they said."

The District Court's Findings.

The District Court found specifically (Fd. 6, R. 759-760): the Wright combination to be "for a combination of elements and the combinations are definitely useful, helpful and good"; that "the elements of each combination cooperate and work together"; that the specification of the Wright patent "gives information to the public as to the construction and mode of operation of the combination," and that there was no commercial use of Wright's invention, nor even of a wind wing, prior to his filing date (Fds. 12 and 16, R. 761 and 763).

The Court of Appeals Decision.

The Court of Appeals said (Dec. p. 3):

> "There is no doubt of the utility of this combination. If Wright was its original and first inventor, the device was patentable to him."

The Court further apparently also found (Dec. page 6) that Wright:

> "• • • devised a new construction which secured a distinctive and new mode of operation and satisfied

a long-felt want for a practical system of closed car ventilation combined with a more perfect and convenient body construction."

Further, apparently (Dec. page 6):

"* * * its use has been attended with commercial success in the way of a better and more satisfactory method of ventilating closed automobile bodies."

And specifically (Dec. page 7):

"* * * the ventilation of closed cars had the attention of body designers and automotive engineers from the first use of such cars."

The Court also found with reference to Wright (Dec. pages 2-3):

"* * * he specifically claims that the swinging front panel has two functions, that of an ejector or extractor of air combined with a shielding effect, which, in conjunction with the operation of the vertical rear panel, causes an inflow of air in the back of the vertical panel and an outflow in the back and front of the pivoted panel, thereby permitting ventilation without subjecting passengers to drafts in the process of changing the air about them."

In, however, concluding that the Wright patent was invalid, the Court of Appeals, while apparently finding in the Wright patent a structure which secured a distinctive mode of operation, apparently read into the prior patents and publications a structure and mode of operation not described therein, and attributed a result which did not follow from the structure described therein and at most only ascertainable from the drawings. The Stafford use was also considered without reference to Wright's principle or mode of operation, which was not proved at all. All of this was without any evidence by respondent in the form of tests of the operation of any of the prior art, and without any rebuttal of Petitioners' evidence of actual tests.

REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT.

Petitioners believe that a Writ of Certiorari should be granted in this case for the following reasons:

I.

That the Circuit Court of Appeals for the Sixth Circuit misinterpreted R. S. 4886 in the light of R. S. 4888, by holding a patent in suit invalid over prior patents and prior publications, where the structure of the patent in suit necessary to secure a new and distinctive principle or mode of operation and result, was not described in any of the prior patents and publications.

II.

That the Circuit Court of Appeals for the Sixth Circuit misinterpreted R. S. 4886 in the light of R. S. 4888, by holding a patent in suit invalid over an alleged prior use where the structure of the patent in suit necessary to secure a new and distinctive principle or mode of operation and result was not proved to have been present in such use.

LITIGATION IN OTHER CIRCUITS IMPROBABLE AND PUBLIC IMPORTANCE.

Although this is the first decision in any circuit on the Wright patent, it is improbable and practically foreclosed that there will be litigation in any other circuit. This court granted certiorari in The Schriber-Schroth Co., Petitioner, v. Cleveland Trust Company and Chrysler Corporation, Respondents, 305 U. S. 47, this court stating, page 50:

> "We later granted certiorari, 304 U. S. 587, on a petition for rehearing showing that, notwithstanding the doubtful validity of the patents, litigation else-

where with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the Sixth Circuit. Cf. Paramount Publix Corporation v. American Tri-Ergon Corporation, 294 U. S. 464; Altoona Publix Theatres, Inc., v. American Tri-Ergon Corporation, 294 U. S. 477."

The judgment of the Court of Appeals for the Sixth Circuit in this cause renders utterly futile any further effort by petitioners to establish the Wright patent except by this Petition. Further litigation in the Sixth Circuit, without a reversal by this court in this cause, would obviously be futile. Even if a judgment upholding the Wright patent were obtained in another circuit, and even if the judgment in the supposed cause were reviewed by this Court, because of its conflict with the judgment of the Court of Appeals for the Sixth Circuit in this cause, and were affirmed by this Court, it would avail your petitioner nothing. In such a case the judgment of the Court of Appeals of the Sixth Circuit would still leave the respondent and its customers immune to the patent. Accordingly, the whole of the automobile industry could readily obtain immunity to the patent by the simple expedient of becoming customers of the respondent, which is located in the Sixth Circuit, conveniently to the automobile industry which is concentrated in the Sixth Circuit, and which can readily supply the window frame assemblies, as it now does to the entire automobile industry, except General Motors and Nash.

The circumstances outlined above, the importance of the subject matter of the Wright patent and its effect on the automobile industry, call for a review of the judgment of the Court of Appeals for the Sixth Circuit in this cause by this Court. Unless this Petition is granted your Petitioners' relief for infringement of the Wright patent is precluded by the judgment of the Circuit Court of Appeals for the Sixth Circuit.

Furthermore, the decision of the Court of Appeals for the Sixth Circuit has misinterpreted R. S. 4886 in the light of R. S. 4888, and this is liable to result in confusion. This court in its early history construed R. S. 4886 with reference to R. S. 4888 in determining the sufficiency of a prior patent or publication; the Cawood Patent Case, 94 U. S. 695, 704; Seymour v. Osborn, and 11 Wall. 516, 555, and in determining the sufficiency of a prior use; Coffin v. Ogden, 18 Wall. 120, 124). However, there has been no discussion of these specific questions by this court for several decades, although this court's views with reference to the sufficiency of the state of the prior art generally has advanced with accumulation of knowledge in the various arts.

Prior to Permutit Co. v. Graver Corp., 284 U. S. 52, decided in 1931, there had been confusion as to the requirements of R. S. 4888 as applied to a patent in suit, which was set at rest in that case. However, after Permutit v. Graver there had been confusion as to the requirements of R. S. 4888 as applied to a pending application, and it was therefore necessary for this Court to set at rest such confusion in The Schriber-Schroth Company v. The Cleveland Trust Company et al., 305 U. S. 47, decided in 1938.

The situation involving the construction of R. S. 4886 with reference to the sufficiency of a prior patent, publication and use has developed like that involving the construction of R. S. 4888 with reference to the sufficiency of a patent in suit, and that confusion has continued since Permutit v. Graver was decided in 1931. The Circuit Courts of Appeals who have followed the principles of the decisions of this court are the third circuit, Root Co. v. Universal Co., 78 F. (2) 991, 994; the eighth circuit, Wisconsin Foundation v. Breon & Co., 85 F. (2) 166, 167; the tenth circuit, Williams Co. v. Hughes Co., 109 F. (2) 500, 510. The Court of Customs and Patent Appeals has even distinguished cases involving a patent asked for and a

granted patent in suit. Thompson v. Dicke, 110 F. (2) 98, 105. The Court of Appeals for the Sixth Circuit has, however, in this case, misinterpreted R. S. 4886, as well as this court's decisions construing that Statute in the light of R. S. 4888. Clearly, it is a matter of public policy that such misconstruction should be cleared up, and that any confusion in other circuits be prevented.

PRAYER.

Wherefore, your petitioners respectfully pray that a Writ of Certiorari be issued to the United States Circuit Court of Appeals for the Sixth Circuit to the end that this cause may be reviewed and determined by this court; that the decree of the Circuit Court of Appeals for the Sixth Circuit be reversed, and that Petitioner be granted such other and further relief as may be proper.

TERNSTEDT MANUFACTURING COMPANY,
GENERAL MOTORS CORPORATION,

By JOHN H. BRUNINGA,
ALEXANDER F. BAILLIO,
Attorneys for Petitioner.

September 23, 1941.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

OPINIONS OF COURTS BELOW.

The opinion of the District Court is found at pages 748 to 756 of the Record; the Findings of Fact and Conclusions of Law at pages 756 to 767; and the Judgment at page 768. The opinion of the Circuit Court of Appeals for the Sixth Circuit, Judges Hicks, Allen and Hamilton, Judge Hamilton writing, appears at pages ..., ..., and has not been reported.*

JURISDICTION.

The judgment of the Circuit Court of Appeals was entered June 25, 1941 (R. ...). The statute giving jurisdiction is Section 240-a of the Judicial Code (28 U. S., Sec. 347).

STATEMENT OF THE CASE.

The foregoing Petition contains a summary of the material facts necessary to the understanding of the reasons relied upon for the allowance of the Writ as well as a statement of the questions involved in the case.

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* A copy is in the Appendix.

SPECIFICATION OF ERRORS.

1. That the Circuit Court of Appeals for the Sixth Circuit erred in holding the Wright patent in suit invalid over prior patents and prior publications, because the structure of the Wright patent necessary to secure its new and distinctive principle, mode of operation and result, was not described in any of the prior patents and publications.

2. That the Circuit Court of Appeals for the Sixth Circuit erred in holding the Wright patent in suit invalid over the alleged Stafford prior use, because the structure of the Wright patent necessary to secure its new and distinctive principle, mode of operation and result, was not proved to have been present in such use.

3. That the Circuit Court of Appeals for the Sixth Circuit erred in not holding the Wright patent in suit valid and infringed, erred in not awarding costs to Petitioners, and erred in not reversing the Judgment of the District Court.

ARGUMENT.

I.

The Circuit Court of Appeals, in holding the Wright patent invalid over prior patents and prior publications, which did not describe the structure of the Wright patent necessary to secure its new and distinctive principle, mode of operation and result, misinterpreted R. S. 4886 as construed by the decisions of this Court.

R. S. 4886, in force when Wright filed, reads as follows:

> "Any person who has invented or discovered any new and useful art, **machine**, manufacture, or composition of matter, or any new and useful improvements thereof, **not** known or used by others in this country, before his invention or discovery thereof, and **not** patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and **not** in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

It will be noted that, as related to the Wright patent, the "new and useful * * * machine * * * invented or discovered" by Wright shall "**not**" have been previously "known or used by others" and "not patented or described in any printed publication"; in other words, in order to invalidate the patent, the machine of the Wright patent **must** have been known or used, or **must** previously have been patented or described in a printed publication.

R. S. 4888, in force at the same time, set forth the requirement of the specification for a patent, warranting the issuance of a patent by the Patent Office, namely,

"* * * a written description of the same (invention or discovery), and of the manner and process of making, constructing, compounding, and using it, **in such full, clear, concise, and exact terms** as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of **a machine**, he shall **explain the principle** thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions."

This Court, beginning with its early decisions, construed R. S. 4886 in the light of R. S. 4888, in determining the sufficiency of prior art as a statutory bar to a patent in suit.

In **Seymour v. Osborne**, 11 Wall. 516, decided in 1870, this Court considered the sufficiency of an article published in "**Mechanics Magazine**," comprising description and drawings. This Court then laid down the requirements of a prior publication as follows (l. c. 555):

"Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the **description and drawings** contain and exhibit a substantial representation of the patented improvement, **in such full, clear, and exact terms** as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention **to the same practical extent** as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defense,

must be **an account of a complete and operative invention** capable of being put into practical operation."

It will be seen that this is a requirement of R. S. 4888.

The Cawood Patent Case, 94 U. S. 695, decided in 1876, involved the sufficiency of a **prior patent.** This Court said (l. c. 703-704):

> "It is plain this **description** and this model* could never have informed anyone of the device Cawood invented. It does not show how the blocks or jaws can be combined so as to leave the upper face of the rail to be repaired exposed for the action of a swage and a hammer. It is said, however, if the upper horizontal bar with its die and jointed levers were taken away, a mechanic might understand how the remnant could be altered and employed as a Cawood machine is employed, and for the same uses. That, however, evades the question to be answered, which is, whether the **specification was sufficient** to enable a mechanic skilled in mechanical arts to construct and carry into practical use the Cawood machine; or, in other words, whether whatever is essential to the Cawood machine could be read out of the prior specification. We think no such information was given by the English patent."

Of course, as in a publication, the sufficiency of the description and drawing are on a par with those of a prior patent and this last case is simply cited for interest's sake.

In 1890 Robinson on Patents restated these principles in his monumental work on patents with reference to a printed publication (Vol. 1, pp. 450, 451, 457). **In 1929** the Circuit Court of Appeals for the Third Circuit in **Skelly Oil Co. v. Universal Oil Products Co.,** 31 Fed. (2d) 427, said (l. c. 431):

> "A patent relied upon as an anticipation must itself speak. Its specification must give in substance the

* At that time it was customary to file a model with the application, which is now rarely done.

same knowledge and the same directions as the specification of the patent in suit."

Prior to Permutit v. Graver, 284 U. S. 52, there was a conflict as to the sufficiency of a drawing under R. S. 4888. While that case involved the sufficiency of a patent in suit, this Court said (l. c. 60):

> "Moreover, while drawings may be referred to for illustration and may be used as an aid in interpreting the specification or claim, they are of no avail where there is an entire absence of description of the alleged invention or a failure to claim it."

It is to be noted, however, that the above statement is followed by a restatement of the requirements of R. S. 4888, as was done in Seymour v. Osborne and the Cawood patent case with respect to a prior publication or a prior patent relied upon.

In **The Schriber-Schroth et al. v. The Cleveland Trust Company**, 305 U. S. 47, the question involved was the validity of a patent whose specification was amended by description of the characteristic feature, where reliance was had upon the drawings showing that feature. This Court, in applying Permutit v. Graver, says (l. c. 59):

> "Gulick also failed to explain the **principle** of his machine so as to distinguish it from the prior art." * * * "But that principle—facilitating skirt constriction rather than obstructing it—was first explained and its embodiment in the flexible-webbed device was first claimed by the amendments to the application."

We, therefore, see that a prior patent or publication must, as to requirement of definiteness, measure up to the requirements of R. S. 4888, and must contain a description of the invention of the patent in suit, and, although of course this description can be aided by drawings, drawings cannot be wholly relied upon in the absence of a

description, and surely not where there are no dimensions given.

Although this Court has not specifically said in so many words, as it did in The Cleveland Trust Company v. Schriber-Schroth with respect to a patent in suit, that a prior patent or publication must explain "principle" of the "machine" of the patent in suit, the following decisions of this Court are really to that effect:

In **Corning v. Burden**, 56 U. S. 252, this Court's definition of "machine," as used in R. S. 4886, clearly applies to the Wright structure, l. c. 267:

> "* * * The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result."

In **Burr v. Duryee**, 68 U. S. 531, 570, this Court defined the "principle" of a "machine," as used in R. S. 4888, as follows:

> "* * * The principle of a machine is properly defined to be 'its mode of operation,' or that **peculiar combination of devices** which distinguish it from other machines."

In **Machine Co. v. Murphy**, 97 U. S. 120, 125, this court stressed the importance of correspondence of mode of operation, function and result, in determining the question of whether two machines are alike in Patent Law. This Court said:

> "* * * the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of **what they do**, or **what office or function they perform**, and **how they perform it**, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to

> obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result."

In **Keystone Co. v. Adams**, 151 U. S. 139, 144, this Court sustained a patent, even though a prior art patent contained the elements of the patent in suit, but with one modified to secure a "**different mode of operation.**" This also follows from Coffin v. Ogden, 18 Wall. 120, 124, discussed later.

Topliff v. Topliff, 145 U. S. 156, involved the question of whether the prior art instance relied upon was designed for the performance of the functions of the device covered by the patent in suit; this Court said (l. c. 161):

> "It is not sufficient to constitute an anticipation that a device relied upon might, by modification, be made to **accomplish the function performed** by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions."

The Eibel Process Case, 261 U. S. 45, involved the question of whether something produced accidentally invalidated a subsequent patent in which the structure was deliberate, intended and appreciated. This Court said (p. 66):

> "* * * accidental results, not intended and not appreciated, do not constitute anticipation."

An improvement in any particular art involves, in the case of a "machine" as we have in the Wright patent, a structure having a "principle" or mode of operation. Obviously, a structure having one mode of operation cannot be the same as a structure having another mode of operation. Accordingly, the requirement that a prior patent

or publication "explain" the "principle" or mode of operation is just as necessary to inform the public of what was old as it is to inform the public as to what is new and to be protected by a patent applied for.

We do not contend that a prior patent or publication must in so many words describe the principle or mode of operation; for a "principle" can be exhibited by a description of "that **peculiar combination of devices** which distinguish it from other machines" (Burr v. Duryee, 68 U. S. 531, 537, supra). However, there must be in the prior art at least a description of structure **which will secure** the mode of operation of the structure of the patent in suit, and that must satisfy R. S. 4888.

The prior patents and publications discussed by the court of Appeals in its decision do not measure up to the requirements of R. S. 4886 in the light of R. S. 4888 in order to constitute statutory bars. These have been discussed in the Statement, so we will briefly summarize here.

The California Top publication, put forward by respondent as the most pertinent automobile reference, admittedly described neither the pivoted nor the sliding panel of the Wright patent, and therefore could not have the mode of operation flowing from the Wright structure. While respondent relied on drawings to show the structure of the publication, petitioner showed by the result of actual tests that even then it did not have the structure to secure the mode of operation of the Wright patent. The same argument applies to the other automobile publications and patent: Gardner, which does not describe the front panel at all Anibal, who describes it as stationary, and Auburn, which has no description except "Auburn design of side wing forming an integral part of windshield" (R. 1555), and not even an illustration of a sliding panel.

The Fennerty patent is for a Pullman car and not for an automobile. The Court of Appeals said (Dec. p. 6): "he had precisely the same elements in his combination as Wright," even though any such thing had to be and was gathered from the drawing, and even though petitioners showed, as the result of actual tests, that the Fennerty structure as advanced by respondent when applied to an automobile as in the Wright patent did not secure Wright's mode of operation, either as to the pivoted panel or as to the sliding panel. Indeed, the Court of Appeals found (Dec. p. 6):

> "* * * Fennerty did not specifically claim or point out that the operation of the intermediate window in connection with the hinged window on each side would bring air from the outside into the car."

In short, none of the patents or publications relied upon by respondent and discussed by the Circuit Court of Appeals describe the structure of the Wright patent necessary to secure Wright's new and distinctive principle, mode of operation or result; and it was not shown that they did, even though the burden was on respondent to do so (Mumm v. Decker, 301 U. S. 168, 171); at least to rebut petitioners' evidence of actual tests that they did not. They did not therefore comply with R. S. 4886 in the light of R. S. 4888, as statutory bars against the Wright patent, because none "described" the Wright structure and none "explain" the Wright "principle." The Circuit Court of Appeals, therefore, misconstrued the Patent Statutes and the decisions of this court in holding the Wright patent invalid.

We do not contend that any particular prior patent or publication must be considered by itself as disclosing everything in the patent in suit; for we concede, as has been held by this Court, that the entire state of the art

may be considered, and that any particular prior patent or publication may be considered in the light of the prior art and read as one skilled in the art would read it. We do not, however, find any prior art instance of the Wright combination of pivoted and sliding panels, with its pivoted front panel, in a door immediately behind and adjacent the windshild, constructed and capable of movement into the bowed-out airstream coming from around the windshield of an automobile. In order to control the movement of air into the automobile through the window opening encompassed by the sliding panel, there must be a pivoted panel which is effective to control such movement, so as to secure, as stated by Wright, "adequate ventilation without objectionable drafts" (R. 796, lines 56 et seq.). None of the prior patents and publications describe such a structure capable of attaining such a mode of operation or of securing such a result.

II.

The Circuit Court of Appeals, in holding the Wright patent invalid over an alleged prior Stafford use, which was not proved to have had the structure of the Wright patent necessary to secure Wright's new and distinctive principle, mode of operation and result, misinterpreted R. S. 4886 as construed by the decisions of this Court.

Much of what we have said under I, supra, about the construction of R. S. 4886 in connection with R. S. 4888 applies here. R. S. 4886 has reference to something in the prior art "known or used by others in this country," but this again must have reference to something described by the patentee. Of course, a prior use of itself cannot have a description of a "principle" mentioned in R. S. 4888, but it must at least have exhibited the principle of the patent in suit prior to its effective date. This is not only clear from Topliff v. Topliff and the Eibel Process Case, cited

under the previous heading, but is also clear from this Court's decision in **Coffin v. Ogden,** 18 Wall. 120, involving the sufficiency of an alleged prior **use.** This Court said (l. c. 124):

> "The invention or discovery relied upon as a defense must have been **complete,** and **capable** of **producing** the **result** sought to be accomplished; and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him. If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view. The law requires not conjecture, but certainty. **If the question relate to a machine, the conception must have been clothed in substantial forms which demonstrate at once its practical efficacy and utility.**"

Here there was no competent and reliable evidence offered by defendant as to how the Stafford car actually functioned from a ventilating standpoint. It is true that Mr. Stafford himself testified, but his testimony, **taken by deposition,** was given **four or five years** after the car had been out of his possession, and he admitted that a month before the deposition was taken **he was "uncertain as to just how it operated,"** and his recollection was different when he testified "since I have seen the car" (R. 323). Neither the District Court nor the Court of Appeals had exhibited to them the Stafford car, but only photographs. In Deering v. Winona, 155 U. S. 265, 301, this court called attention to the possibility of even conscientious witnesses "being mistaken as to the exact device used," which may differ from the one patented "in the very particular which makes it patentable."

Plaintiffs' witnesses testified that they had tried out a structure like that of Stafford and that it did not function as did the Wright structure, because the Stafford vane did not extend into the bowed-out airstream (R. 533, 534, 542-544), and, of course, because the sliding panel did not move down to open and up to close (R. 532-4, 691). We have no rebuttal of this by any of the defendant's witnesses as a result of actual tests, although such tests could have been readily made by defendant, but only statements by a professional patent expert.

We do not contend here that if the Stafford car had been proved as to its structure before Wright filed his original application on August 2, 1926; if it had been shown that the Stafford structure as now appearing was the same as it appeared at that time; and if it had been further shown by actual tests that such structure had the principle or mode of operation and secured the results of the Wright structure; that the Stafford structure would not then have anticipated the invention of the Wright patent in suit. However, defendant has failed to do this altogether.

Here again the Stafford car, **even if proved**, was not shown to have had, prior to Wright, the structure of the Wright patent necessary to secure Wright's distinctive principle, mode of operation or result. It did not therefore comply with R. S. 4886, in the light of R. S. 4888, as a statutory bar against the Wright patent, and the Court of Appeals misconstrued the Patent Statutes and the decisions of this Court in holding the Wright patent invalid.

CONCLUSION.

From the foregoing we submit that the Circuit Court of Appeals for the Sixth Circuit has misinterpreted R. S. 4886, by holding the Wright patent invalid over prior patents, prior publications and an alleged prior use, and that important questions of patent law are presented here,

which are important not only to these Petitioners, but to the public, inventors and industry at large. Petitioners can have no relief under the circumstances of this case unless this Court grants Certiorari. The Wright patent presents an exceedingly valuable contribution to the automotive industry, as is evidenced by the fact that, although it was applied for fifteen years ago and has been in use nearly a decade, it still remains the only solution of the problem which faced the industry from the beginning of closed cars nearly a quarter of a century ago.

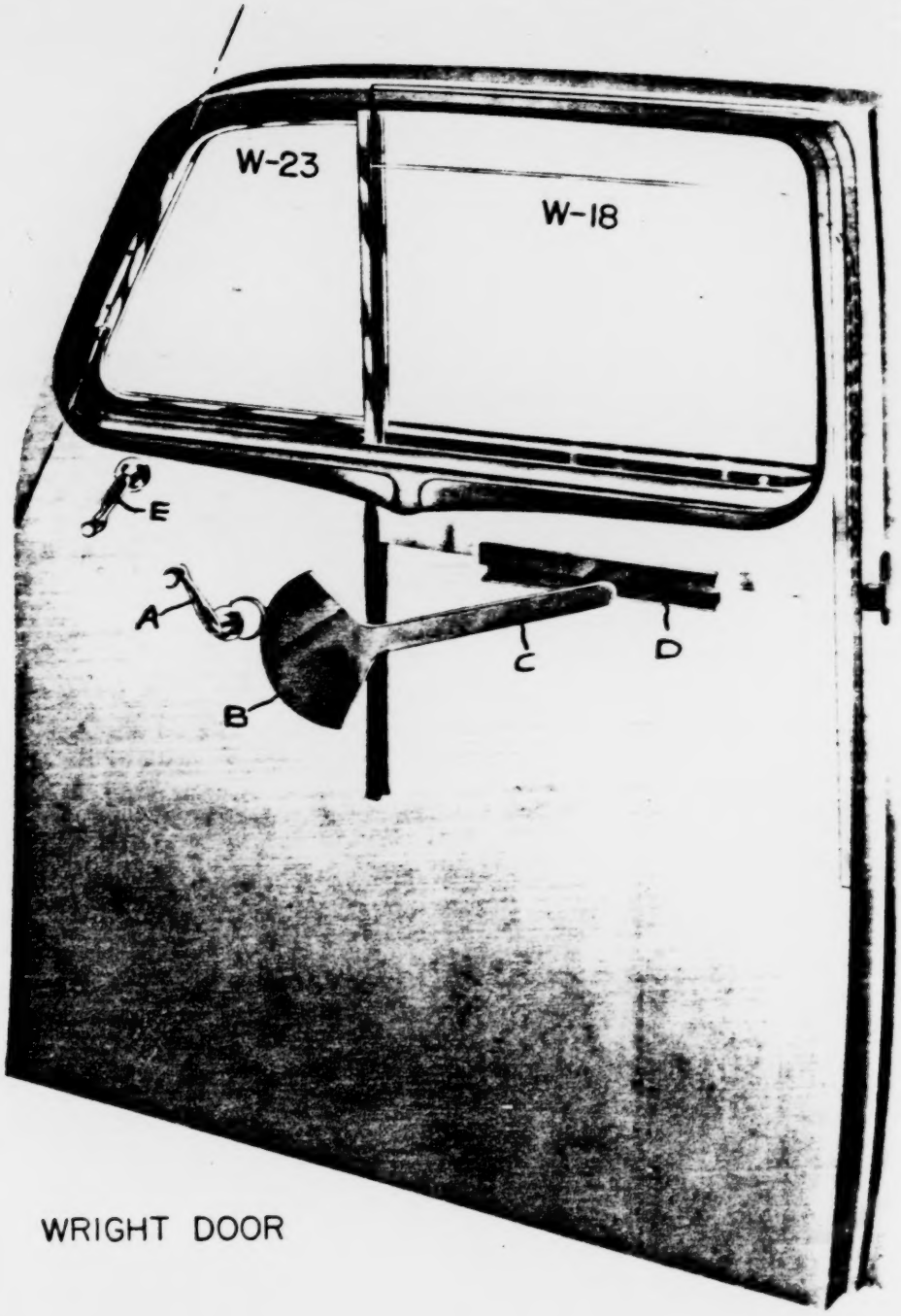
Wherefore, your Petitioners pray that their petition be granted, that the Writ of Certiorari be issued and the cause reviewed, and that the decree of the Court of Appeals be reversed.

Respectfully submitted,

JOHN H. BRUNINGA,
ALEXANDER F. BAILLIO,
Attorneys for Petitioners.

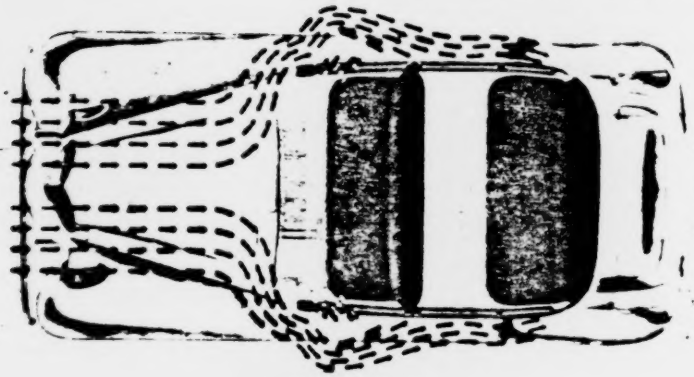
September 23, 1941.

PLAINTIFFS' EXHIBIT NO. 1-C.

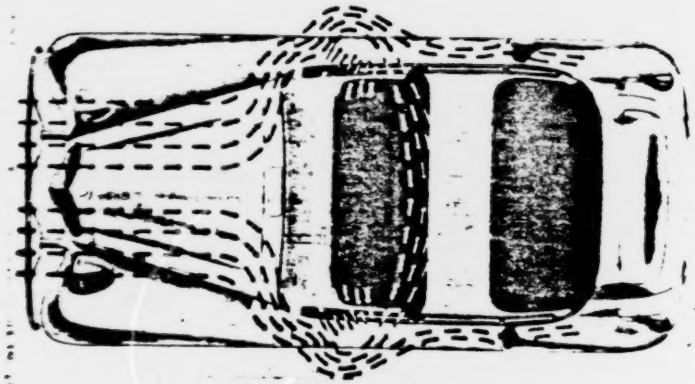


WRIGHT DOOR

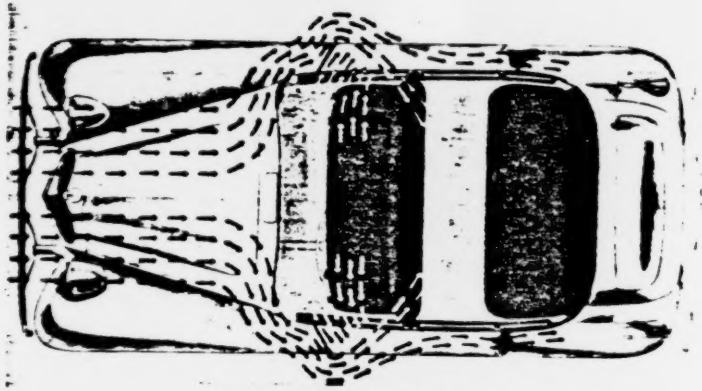
PLAINTIFFS' EXHIBIT NO. 1-E.



WRIGHT VANES AT 60°
VERTICAL SLIDING PANEL CLOSED



WRIGHT VANES AT 60°
VERTICAL SLIDING PANEL ONE HALF OPEN



WRIGHT VANES AT 60°
VERTICAL SLIDING PANEL FULL OPEN

APPENDIX II.

Filed Jun 25 1941 John W. Menzies Clerk.

No. 8623

UNITED STATES CIRCUIT COURT OF APPEALS

SIXTH CIRCUIT

TERNSTEDT MANUFACTURING COMPANY and GENERAL MOTORS CORPORATION, *Appellants,*

v.

MOTOR PRODUCTS CORPORATION, *Appellee.*

APPEAL from the United States District Court for the Eastern District of Michigan, Southern Division

Decided June 25, 1941.

Before HICKS, ALLEN and HAMILTON, Circuit Judges.

HAMILTON, Circuit Judge. Appellants, Ternstedt Manufacturing Company and General Motors Corporation, appeal from a judgment dismissing their bill of complaint against appellee, Motor Products Corporation, for alleged infringement of two patents, namely, the Wright reissue patent No. 18866 dated June 13, 1933, for window construction in the body of a closed vehicle, and Fisher patent No. 2048605 dated July 21, 1936, for closed car ventilation, appellant Ternstedt Manufacturing Company, a wholly owned subsidiary of appellant, General Motors Corporation, being owner of each patent by assignment. Claims 1, 8, 10, 11, 15, 16 and 19 of the Wright patent are in suit and all claims of the Fisher patent, five in number. Claim 10 of the Wright patent and claim 1 of the Fisher are typical and are in the margin.[1] The Wright

1 10. A window for a vehicle body comprising a window casing having a well in the lower portion thereof, a transparent panel mounted to slide vertically in said casing and well and adapted to close a portion of the window opening, a second transparent panel pivotally mounted on an up and down axis in said casing adjacent the window opening and swingable to cooperate with said sliding panel in closing said window opening.

1. In a vehicle body, the combination with a closed body-wall structure including a window opening and well therebelow, or a panel supported in the front of the window opening on pivots to swing on an up and down

original patent No. 1,861,828 was issued June 7, 1932, on application, serial No. 126,576 filed August 2, 1926, and Wright reissue patent No. 18866 was granted June 13, 1933, on application, serial No. 644,726 filed November 28, 1932. The Fisher patent was issued on application No. 644,622, dated November 28, 1932.

Wright claims that, prior to his invention, windows in closed moving vehicles operated only vertically and could not be utilized for interior ventilation without causing uncomfortable drafts and their extensive use for ventilation was not feasible in inclement weather, because of the entry of rain or snow into the interior and that the prior construction of closed vehicle bodies, particularly bodies in which the front door jamb also formed the corner post for the windshield, made difficult the use of a slanting windshield without corner posts so large as to obstruct the vision of occupants. He claims by his invention to have overcome or lessened the effects of all the above difficulties.

The essential features of his improvement of the glass portion of automobile bodies are the division of the old sliding, vertical glass frame into two parts, each separately framed, the back panel moving vertically in channel frames in the conventional manner, and the front panel pivoted on its front edge and the rear end swingable outwardly and retainable in numerous positions by individual control of the occupant. It is operated by irreversible gear connection mounted in the door, which connection is separate from that controlling the back panel.

Broadly stated, Wright proposes to have a window frame with a vertically sliding window adapted for closing or opening the rear portion thereof and a hinged window for opening or closing the remaining front portion and he specifically claims that the swinging front panel has two functions: that of an ejector or extractor of air combined with a shielding effect, which, in conjunction with the operation of the vertical rear panel, causes an inflow of air in the back of the vertical panel and an out-

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axis substantially forward of the midpoint of the widest portion of the panel to provide a substantially major area of the panel to the rear of the pivot, means by which the panel is prevented from turning front edge outwardly and the rear edge inwardly from closed position, the said panel being adjustable on said pivots to bring the rear section outwardly and held against undesired actuation in any of numerous angular positions up to substantially 90 degrees (measured on an arc to the rear of said panel axis) or more to the longitudinal center line of the car, and an upwardly and downwardly adjustable rear panel complementing said front panel and adapted to fill the space left in said window opening when the front panel is in closed position thereby forming a composite window opening closure.

flow in the back and front of the pivoted panel, thereby permitting ventilation without subjecting passengers to drafts in the process of changing the air about them. He also claims, by use of this construction, smaller corner posts may be utilized for slanting windshields which is desirable because better vision is afforded.

The rare and the new features, if any, in Fisher's alleged invention are so covered up in his specifications with the familiar and the old as almost to defy detection. Obvious and familiar things often impede us in our search for things that are rare and remote, but by the use of such industry of intellect as we possess, busily exerted, sifting the old from the new in Fisher's specification, it appears that the only change he made from that of Wright is that the pivot point for the swinging panel is located intermediate of the front and rear edge of the panel rather than at its front edge, so that when it is swung about this intermediate axis, a portion of the panel swings out into the air stream providing an opening at the front of the axis of the pivots through which air may be introduced.

Considering the concrete exemplification of the invention set forth in the present patents, it appears they are a combination of two elements; (1) a swinging window in the frame of the vehicle which can be positioned to permit the influx of currents of air into the vehicle body and which can also be positioned so that the motion of the vehicle tends to induce air to flow from its interior; (2) a vertical sliding glass window of the conventional type, which complements the swinging window and which at different adjustments in cooperation with the swinging window acts to permit flow of air from the vehicle and its influx therein.

There is no doubt of the utility of this combination. If Wright was its original and first inventor, the device was patentable to him. Under the well known rule of interpretation of patents, we immediately compare his alleged invention with the prior state of the art in order to ascertain the particulars, if any, in which the concrete exemplication of his invention as set forth in the specifications, has been differentiated from whatever device nearly akin which had preceded it.

The first closed car utilized movable windows for ventilation and window panes adjustable to various angles which, with the car in motion, would draw in fresh air and eject stale air. It is a matter of common knowledge that the closed body type of automobile first came into wide use in 1921. In February, 1922, P. W. Steinbeck, at the annual meeting of the Society of Automotive En-

gineers in New York, read a paper entitled "California Top," relating to the body structure of motor vehicles in which he described a structure built onto a conventional open body car with the purpose of converting it into a substantially closed car. He pointed out the division of the front window into two panels, the rear one slidable horizontally and the front one hinged at its front edge and adjustable as a wind deflector. The panels of the other windows also slid horizontally because of the adjustable top.

In December, 1924, Elmore H. Stafford had an R. V. Knight open touring car converted into a closed body type in which there were windows replacing the usual side curtains. The windows in the car had a metal frame, triangular in shape, the front member slanting and coinciding with the slant of the windshield. The front window was mounted in the door and had two panes, a front one fixed and a back one which slid forwardly over the front one so when the back pane slid forward, one-half of the window would open. At the front of the body a piece of plate glass was pivoted centrally in a frame so as to swing. On the inside of the top was a thumb screw, by turning which the glass could be fixed in any desired position. It would not rotate in a complete circle because of rubber weather stripping inserted in the inner side of the frame for the purpose of making a tight connection when closed.

In May, 1926, the Motor World published an article describing the Gardner Landaulet, a two-passenger car with a convertible top in which the windshield was in one piece and stationary, equipped with side frames with glass in them, which it was stated could be opened for ventilation. The glass in the doors could be raised or lowered whether the top of the car was up or down.

Wind wings for cars were developed as early as 1919 and used as attachments in connection with windows of conventional closed cars from the inception of these types of bodies. They were fixed structures built at the side of the windshield of touring cars in front of the door. In 1922, the Auburn car showed a design of side wings forming an integral part of the windshield and in 1923, its wind wings were placed in a frame, pivoted centrally, and could be operated in a complete axis, except when the windows to which they were complementary were closed. Prior to 1930, the Dole Valve Company advertised the "Dole Wind Wings" for attachment to any car which it claimed ventilated the car and, when used in door openings, acted on the same principle as the Louvre opening in the hood and pointed out that the vacuum

created behind the deflectors by the forward motion of the car, sucked the stale air from the interior and at the same time allowed fresh air to enter without creating disagreeable drafts and unpleasant cross currents.

In 1932, the General Motors Corporation used on its La Salle cars the Dole wings in the front and rear, which were pivoted in front of the center and operated substantially as Fisher and performed approximately the same function when the complementary sliding panel windows were open full width. When these windows were closed the wings were inoperative.

Prior to 1932, the Dole Valve Company endeavored to interest Fisher in the Dole wings, which were exhibited to him and when preparing the specifications for his invention, he gave particular consideration to their method of operation and the substance of his invention was to eliminate the wings as supplementary to the glass portion of the door and make them an integral part of it, putting them in a frame complementary to the sliding window.

On October 21, 1930, a motor publication, in describing the advantages of the Rolls-Royce car, stated it had the vertically sliding window in the rear of the front door and a vertical pane in the front part of the door pivoted somewhat ahead of the center and swingable from the closed position to a substantially angular open position, allowing for ventilation without draft.

Fennerty, in his patent No. 333,620 dated January 5, 1886, issued on application No. 167,421 filed June 2, 1885, for a car window, stated his invention related to the construction of car windows adapted to facilitate observation and ventilation and to prevent the entrance of dust and dirt. The main features of his invention, broadly stated, were the combination of two independently attached, laterally swinging windows pivoted at the edge onto opposite sides of an intermediate sliding window, which could be raised or lowered into the body of the car. He claimed perfect ventilation and an extended field of vision were obtained with complete exclusion of dirt and dust by the use of his combination.

Fennerty's construction was applied to a closed railroad car. He pointed out that those skilled in the art to which his invention related might apply his combination by constructing in the car a window casing with the two pivoted outer windows, one to be swung out when the car was moving in one direction and the other when the movement was reversed. He claimed, by this arrangement, perfect ventilation would be achieved.

The evidence shows that, taking into consideration the specifications of Fennerty, he had precisely the same elements in his combination as Wright. However, Fennerty did not specifically claim or point out that the operation of the intermediate window in connection with the hinged window on each side would bring air from the outside into the car.

The Anibal patent No. 1,542,595, dated June 16, 1925, described how the front door of closed automobiles could be constructed to fit against a rearwardly inclined windshield with the front glass panel divided vertically, the front panel stationary and the rear panel vertically slidable.

The preponderance of the evidence shows that the use of inclined windshields in conjunction with vertically movable glass in the doors of automobile bodies was old to the art at the time Wright filed his original application, and that the use of separately pivoted glass portions adjacent to the windshield had been previously taught.

Appellants do not seriously controvert these facts, but insist that their assignors, by the specific arrangement and mounting of the panels in their inventions were the first to devise a combination which would adequately and properly ventilate an automobile and were also the first to point out a method by which a movable or divisible windshield could be eliminated in automobile bodies and adequate ventilation retained.

They claim their inventors devised a new construction which secured a distinctive and new mode of operation and satisfied a long felt want for a practical system of closed car ventilation combined with a more perfect and convenient body construction.

In considering the patentability of the present combination, we must not be misled by the fact that its use has been attended with commercial success in the way of a better and more satisfactory method of ventilating closed automobile bodies for in the steady advance incident to manufacturing progress, numerous non-patentable processes and methods have proved original and exceedingly profitable, but not everything useful and novel is patentable. *Paramount Publix Corporation* v. *American Triergon Corporation*, 294 U. S. 464, 476; *Textile Machine Works* v. *Hirsch Company*, 302 U. S. 490, 499.

Automobile body designers have much for which to thank the early carriage builders, without whose example and traditions they would have been unable to make such

rapid progress, nevertheless, their slavishness to the past caused them to lean too heavily upon the horse-drawn vehicles instead of going deeper into the origin of such features and forming a true appreciation of the new problems which the change in the manner of locomotion involved. The progress of the closed car in proportion to the number of open cars produced was very slow but the necessity of protecting the occupants of gasoline powered motor vehicles against the dangers of monoxide gas poisoning was early recognized and the ventilation of closed cars had the attention of body designers and automotive engineers from the first use of such cars and the improvements in this respect have been slow but steady. Each useful art has a technique recognized and practiced by those skilled in it which is broadened in its usefulness by following precedent.

One step is followed by another by those skilled in the art to meet the demand for advance. This is evolution and the step thus made not invention. Sometimes the advance along certain lines slows down and almost stops notwithstanding the demand and the efforts of those skilled in the art to continue the progress. At that point some one, "nourished by knowledge patiently won, bounded and conditioned by co-operant reason," takes a step, often a small one, but one which turns the halt into progress again. This is often true invention and yet may have the appearance of mere carrying forward, or the exercise of mere mechanical skill. Invention and patentability intervene only when another sort of mental faculty not possessed by those skilled in the art has come into play. *Bullock Electric Mfg. Company* v. *General Electric Company*, 149 F. 409 (C. C. A. 6). It is often difficult to draw the line between patentability and improvements or adaptations. Each case must be decided on its peculiar facts. *Roemer* v. *Simon*, 95 U. S. 214, 218.

Neither at the time Wright filed his application for his original patent nor at the time of reissue, had there been any halt in the art of designing or improving automobile bodies or their ventilation and this was true at the time Fisher filed his application. All inventors interested in upholding or defeating a patent are presumed to be fully acquainted with the state of the art when they apply for a patent or when they devise their combination. Every patentee, it must be assumed, borrowed from the other whatever was theretofore invented or known in the art to which his invention related, and in considering the state of the art, we are not required to overlook the fact of the cumulative growth of both

inventions and scientific knowledge and their great diffusion among all the people. *Mast, Foos & Company* v. *Stover Mfg. Company,* 177 U. S. 485, 493.

It has been generally known for a long time that when a solid body starts from rest to move through the air which is otherwise undisturbed, the form of the flow of air around the moving body is uniquely determined by the shape and mode of motion of the body and that the outflow and inflow of air is controlled by the shape, size and positions of the openings into the body. This general principle of aerodynamics has been long applied by those skilled in the art both to affect the flow of air on the passage of solid bodies through it and their internal ventilation. Wright and Fisher, having available to them all the general knowledge relating to the problem either of them may have solved and being chargeable with notice of all the pre-existing devices relating to the subject, in our opinion, the inventive faculty was not exercised by Wright in dividing the glass portions of the doors of automobile bodies into two parts and attaching one part to a movable hinge leaving the other slidable, nor by Fisher in fastening Wright's front window on pivots centrally located rather than on the side as in Wright. Neither of them invented a new device nor used an old device or a combination of old devices for a new purpose. All either did was to apply an old combination to an old purpose with a slightly different arrangement. The results added to the efficiency and popularity of the older combination but in our opinion did not rise to the dignity of an invention. *Mast, Foos & Company* v. *Stover Mfg. Company,* supra.

Decree affirmed.

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IN THE

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OCTOBER TERM, 1941

No. 652

TERNSTEDT MANUFACTURING COMPANY
and GENERAL MOTORS CORPORATION
Petitioners,

v.

MOTOR PRODUCTS CORPORATION,
Respondent.

RESPONDENT'S BRIEF ON PETITION FOR WRIT OF CERTIORARI

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TERNSTEDT MANUFACTURING COMPANY and GENERAL MOTORS CORPORATION
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Respondent.

RESPONDENT'S BRIEF ON PETITION FOR WRIT OF CERTIORARI

I.

This is an ordinary patent case. Both the District Court (Eastern Dist. Mich. S. Div.)[1] and the Circuit Court of Appeals for the Sixth Circuit[2] held all of the claims in suit invalid for anticipation or lack of invention in the light of the prior art. The Bill of Complaint was dismissed on that ground.

[1]The District Court opinion will be found at 30 F. Supp. 288 and at Vol. I, page 748 of this record; the Findings of Fact and Conclusions of Law are at Vol. I, page 756.

[2]The opinion of the Circuit Court of Appeals will be found at 50 U. S. P. Q. 259 and has been included as an appendix to petitioners' brief.

There is nothing in the present petition which brings this case within any of the provisions of Rule 38, Sec. 5 of this Court relating to the granting of writ of certiorari. There is no conflict of opinion between Circuit Courts of Appeal, no unsettled legal propositions, and no question of general or public interest.

II.

The petition cites the case of the *Schrieber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47 as precedent for the granting of this petition but the situation in that case was exactly opposite to that which exists here. There certiorari was granted because the patents in suit (relating to automobile pistons) had been **sustained** and the patent owners could control the entire automotive industry **without moving from the Sixth Circuit**. Here the patents have been held to be invalid **and there is absolutely nothing to prevent petitioners from suing in any other circuit**. Automobile companies do business in every state of the union and large quantities of the ventilating windows here in suit are made by others than Respondent and used by various automobile companies. The alleged futility of petitioners filing suits in other jurisdictions is mythical (except for the likelihood of again being defeated). The situation here is no different from that which exists in any case of an unsuccessful plaintiff in a patent suit. If petitioners' position were sound, then this court should grant writ of certiorari in every case where a court of Appeals holds a patent invalid.

III.

The gist of petitioners' contention that the Court of Appeals misinterpreted R. S. 4886 and R. S. 4888 is that the prior art did not really disclose the invention of the Wright patent in suit. In finding that the prior art (in-

cluding the patents, publications and a prior use) did disclose the same inventive concept as Wright, neither the District Court nor the Circuit Court of Appeals announced any theory or statement of law which is contrary to that established by this court or which follows a new or uncharted channel. In substance, petitioners' contention is merely that both courts were incorrect in their findings. That petitioners are dissatisfied with the findings is no reason for the granting of writ or certiorari.

IV.

Petitioners having failed to show any reason, except dissatisfaction with the decision of the Circuit Court of Appeals, why their petition herein should be granted, a discussion of the merits of the case would appear unnecessary. The short statement and argument which follow are included solely for the purpose of making available to this Court a very brief explanation of some of the issues that were presented to and decided by the Court of Appeals.

STATEMENT

From the time that closed automobile bodies were first built it has been the practice of automobile manufacturers to provide a vertically sliding window in the front door of the car. Raising of the window completes the enclosure while lowering of the window permits the ingress and egress of air to and from the interior. The only thing which the patentee Wright (II, 793, I, 26) did to this conventional construction was to insert in the window opening, forwardly of the vertically slidable window pane, a pivoted wing or panel secured to the front door pillar so it might pivot about its front edge. When this pivoted wing is swung outwardly about its front pivot, the rear edge is

moved away from the car body leaving an opening through which air may be **withdrawn** from the car body as a result of suction or ejector action induced by the forward movement of the car itself. Wright says in his specification (page 2, lines 32-35):

> "When the window 23 is in position A or any intermediate position, the motion of the vehicle induces air to flow *from* the interior of the vehicle outwardly * * *."

Wright's window 23, being pivoted at its forward edge, did not permit intake of air at the forward edge nor did it provide means for forcing air into the car.

Contrary to the impression left by the petition and accompanying brief, this structure **has not been adopted or used** by any American manufacturer of automobiles. The constructions involved in this suit and those used by other American automobile manufacturers are more of the type disclosed in the Fisher patent No. 2,048,605 (II, 805, I, 26) which provided means for forcing air into the car. This Fisher patent was also held to be invalid by the District Court and by the Circuit Court of Appeals but it is not urged in this petition. As petitioners no longer rely upon the Fisher patent we need not refer to the prior art invalidating it.

The original Wright patent played absolutely no part in the development of what petitioners choose to call "no draft ventilation." Wright was not even known to petitioners until the original Wright patent was issued, just prior to the commercial production by petitioners of the construction shown in the Fisher patent. They elected to purchase the Wright patent for a nominal amount and to reissue it in an endeavor to secure broad claims with which they might blanket and dominate the art. The original patent as issued did not contain claims broad

enough to do this, although Mr. Wright had unsuccessfully attempted to secure such broad claims during the prosecution of his patent application. The broader claims which were obtained by the reissue (not limited to pivoting the panel along its front edge or to the door front pillar) are invalid because they are not different from similar claims which Mr. Wright had endeavored to obtain but had cancelled from his application after rejection by the Patent Office. (*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., et al*, 294 U. S. 477, 492.) The District Court and the Court of Appeals apparently found it unnecessary to hold the claims invalid for this reason because they found the claims to be clearly anticipated and invalid over the prior art.

Petitioners' many statements regarding the commercial success of Wright and what they consider to be favorable remarks of the court regarding "the ventilating arrangement involved in this case" do not apply to the disclosures of the Wright patent for the very simple reason that **the Wright structure has never been used** in this country. Neither of the courts below found that the Wright structure had been used by any American manufacturer, although the District Court found that certain of the broad claims of the Wright reissue patent would read on respondent's devices, if the claims were valid. Petitioners ingeniously intertwine the Fisher patent, the Wright patent and so-called "no draft ventilation" to have it appear that all statements made by them and the courts below apply specifically to the Wright patent, but such is not the case. It is only by the provision of means for **directly inducing air into** the car body, through a pivoted window, that any commercially desirable system is provided. As stated above, Wright is completely deficient in this respect.

The use of a pivoted window construction as a means of ventilating a car followed a conventional and routine pattern. It was first proposed for railroad cars, then for open automobiles and then for closed automobiles. In closed automobiles it was first built in custom or tailored installations and as an accessory. Finally it was built in as standard equipment by one large manufacturer so that its customers no longer had to buy it as an accessory. Other manufacturers also provided it as standard equipment, in order that their customers would not have to pay the accessory price. In making the standard equipment installations, the manufacturers simply assembled these early devices bodily into the cars as built and delivered from the factory. This was the same pattern as had been followed in adopting as standard equipment such items as windshields, speedometers, shock absorbers, radiator shutters, bumpers, water temperature indicators, etc. (I, 347, 348).

ARGUMENT

Both the District Court and the Court of Appeals found the broad claims of the Wright reissue patent to be anticipated and invalid over various prior art structures, many of which included the feature in which Wright was deficient—the arrangement of the wind wing so as to force or blow air into the car body. This prior art included, among others, United States patent to Fennerty No. 333,620, the article entitled "Development of the California Top" in the publication AUTOBODY of February 1922, and the R & V Knight car as used by Stafford. A series of prior art disclosures appears in the record Vol. II, pages 1509 to 1609.

FENNERTY PATENT NO. 333,620

The Fennerty patent (II, 1521, I, 266) disclosed a Pullman car having conventional sliding windows, each sliding window having a pivoted window or wing on each side thereof. A Pullman car, of course, might be run in either direction, and the provision of a pivoted window on each side of the sliding window made it possible for the pivoted window which happened to be on the front side of the sliding window to be opened to give the desired ventilation or extraction of air from the car body. Fennerty describes exactly the same function and operation as is described in the Wright patent. Wright's specification states as his object "to ventilate thoroughly and well the interior of the vehicle without producing violent drafts" and says that "this is accomplished by" providing the pivoted panel which, when in open position, enables the motion of the vehicle to "induce air to flow **from** the interior of the vehicle outwardly." Fennerty's specification states that he obtains "perfect" and "complete" ventilation by the use of his pivoted panel which, when in open position functions so that "the foul air of the car is **drawn out**, on the ordinary ejector principle." Wright says his pivoted panel, when functioning to ventilate, excludes "the entry of rain or snow to the interior of the vehicle," while in Fennerty his panel functions to ventilate with the "complete exclusion of dirt, dust, etc." The District Court said (I, 751),

> "I think Fennerty and Wright are about as near alike as two peas in a pod."

That the disclosure of Fennerty is full and complete was admitted by petitioners' expert witness (I, 655),

> "Q. Well, Wright doesn't teach you anything more about the operation of the structure which he

discloses, namely a swinging panel in front of a vertically sliding panel than Fennerty does, does he?

"A. I believe that is a fair statement."

Petitioners' counsel attempted to differentiate Wright over Fennerty because Fennerty showed his ventilating system in a Pullman car instead of in the door of a motor car, but that contention is contrary to the statement in petitioners' Fisher patent (II, 805) that these ventilating systems are applicable to moving vehicles including not only automobiles but "**railway cars**, boats, airplanes and other vehicles." That it makes no difference whether the ventilating window is provided in the door or in the side of the car is borne out by the testimony of petitioners' own expert witness (I, 99, 100) that:

> "Obviously when the door is closed the panels do not know whether they are attached to the door or to the body. * * * If we wanted to weld up the door (of the Wright structure, for example) into the side of the body, the ventilation operation would be the same."

The District Court summed up the situation when it said (I, 752):

> "I place no importance on the fact that Fennerty applied the construction to a closed railroad car body rather than to a closed automobile body. They are both closed vehicle bodies which move at relatively high speed, and *the problem of letting air in and out without subjecting the passengers to undesired drafts is the same in both,*"

and when it made the finding of fact (I, 764):

> "19. The ventilating window arrangement of the Fennerty Patent No. 333,620, January 5, 1886, is identical in all material respects relating to both structure and operation with the ventilating window arrangement described and claimed in the Wright reissue patent."

Fennerty is a complete anticipation of the broad claims of the Wright reissue patent and contains a complete description of the function and mode of operation thereof.

THE PUBLICATION "AUTOBODY" OF FEBRUARY 1922

This publication (II, 1543, I, 266) disclosed a pivoted panel or wing A, exactly the same as that of Wright and shows it applied to an automobile body. The only distinction between this disclosure and the Wright disclosure is that Wright showed his pivoted panel or wing applied to a conventional closed automobile body having vertically slidable main windows while the publication showed the pivoted panel or wing in conjunction with a fore and aft slidable window such as was conventionally used with so-called "California tops" which were designed to make closed cars of what had originally been open cars. There is no difference whatever in the functioning of the pivoted panel, whether it is used with a window which slides fore and aft or up and down. California tops, being built for installation on open cars, could not have their windows slide up and down because no provision had been made in the cars as originally built to receive the window if it were lowered. Nothing could be more obvious to the original builder of a motor car, if he wanted to use the pivoted window of this publication in a closed car, than that he should use the conventional vertically sliding window which he had always used when building a closed car.

Referring to the disclosure of this publication, the District Court formally found (I, 765):

> "The front window of this car is divided into two panels—a rear panel which is slidable and a forward panel which is hinged at its front edge to provide an adjustable wind deflector. This construction is identical in all material respects, relating to both structure and operation, with the ventilating

window arrangement described and claimed in the Wright reissue patent. The fact that the rear panel of the California top construction opens by sliding horizontally instead of sliding vertically, as in the Wright patent, is of no significance either as a matter of structure or as a matter of result."

Every function and purpose of the Wright patent is disclosed in this publication.

THE R & V KNIGHT CAR AS EQUIPPED AND USED BY STAFFORD

Long prior to the Wright patent, Elmore H. Stafford, a lawyer of Rock Island, Illinois, purchased an R & V Knight open touring car which had as **standard equipment** a pivoted window positioned immediately back of the windshield. This window had its pivot so arranged that the window could not only be swung to **extract** air from the car but could also induce air to flow **into** the car, and Mr. Stafford testified (I, 314-316) that he had used the window throughout his ownership of the car for both purposes.

The actual car owned by Mr. Stafford was produced and was available at the taking of his testimony and at the trial. Photographs of the same were introduced in evidence (II, 1605-1609, I, 314-316). These photographs show the so-called "California top" enclosure windows which were installed in this car by Mr. Stafford in order to make it into a closed car. The proofs of the purchase of the car and the installation of the California top or sliding windows were clearly corroborated by documentary evidence so that the facts of its existence, use and operation were accepted as clearly established by both of the courts below.

As we have already indicated, this construction not only anticipates and invalidates the broad claims of the Wright reissue patent, but, in fact, constitutes a system much better than Wright and more nearly like that employed by respondent.

OTHER PRIOR ART

There were various other prior art references referred to by the courts below, including wind wings of various kinds used as accessories before the automobile companies decided to incorporate them as standard equipment. It seems unnecessary, however, to prolong this brief by reference to them.

CONCLUSION

It will be seen from the foregoing that the many decisions referred to in petitioners' brief have no application here for the simple reason that the decisions of the courts below are not in conflict with them. As a matter of fact, the law announced in those decisions was followed and applied in holding the broad claims of the Wright reissue patent invalid. **Petitioners have not pointed out a single statement in the opinion of the Court of Appeals which is in conflict with the decisions referred to by petitioners.**

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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(27)

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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1941.

TERNSTEDT MANUFACTURING COMPANY and GENERAL MOTORS CORPORATION,
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vs.
MOTOR PRODUCTS CORPORATION,
Respondent.
No. 652.

PETITIONERS' REPLY BRIEF ON PETITION FOR WRIT OF CERTIORARI.

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IN THE

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OCTOBER TERM, 1941.

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PETITIONERS' REPLY BRIEF ON PETITION FOR WRIT OF CERTIORARI.

We will reply seriatim to Respondent's Brief.

I. This is not an ordinary patent case, but involves important questions of patent law and a situation of importance to inventors as well as those who are induced to purchase patents. There are, therefore, "special and important reasons" for the granting of the Writ as stated in this Court's Rule 38, Sec. 5; and although this Rule states that the illustrative reasons given are "neither controlling nor fully measuring the court's discretion," here the Court of Appeals "has decided a federal question in a way probably in conflict with applicable decisions of this court."

Note: All emphasis in this Reply Brief is ours.

II. The situation, in principle, is not different than it was in Schriber-Schroth v. Cleveland Trust, 305 U. S. 47, 50. Here, unless this Court reverses the Court of Appeals, Respondent can keep on as it has been doing, namely, supply the automobile industry concentrated in the Sixth Circuit and "without moving from" that Circuit; for it is not a fact (Rep. Br. p. 2) that "large quantities of the ventilating windows here in suit are made by others than Respondent"; unless we include Petitioners in those "others." It was admitted that Respondent supplies Chrysler and Hupp (R. 84) and also Ford and Willys-Overland (R. 552), all in the Sixth Circuit; and this Court can take judicial notice of the fact that those automobile manufacturers produce nearly all of the automobiles in this country not produced by General Motors. What would it then avail Petitioners to sue, with Respondent and its customers immune from the Wright patent? The fact that Petitioners can continue their use of the Wright patent cannot affect the patent question, for as this Court said in Bauer v. O'Donnell, 229 U. S. 1, 10:

> "The right to make, use and sell an invented article is not derived from the patent law. This right existed before and without the passage of the law and was always the right of an inventor. The act secured to the inventor the exclusive right to make, use and vend the thing patented, and consequently to prevent others from exercising like privileges without the consent of the patentee."

There can be no distinction made, as Respondent seeks to do (Resp. Br. p. 2), between a case where a patent has been sustained and one where it has been held invalid, because the Patent Laws, as construed by this Court, protect the rights of a patentee as well as the rights of the public; for as this Court said in United States v. Dubilier Condenser Corp., 289 U. S. 178, 186:

> "An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of value to the community by adding to the sum of human knowledge." . . . "He may keep his invention secret and reap its fruits indefinitely. In consideration of its disclosure and the consequent benefit to the community, the patent is granted. An exclusive enjoyment is guaranteed him for seventeen years, but upon the expiration of that period, the knowledge of the invention enures to the people, who are thus enabled without restriction to practice it and profit by its use."

III. Petitioners' contention is not simply "that the prior art did not really disclose the invention of the Wright patent," but that the Court of Appeals misinterpreted R. S. 4886 in the light of R. S. 4888, as construed by the decisions of this Court.

IV. The reasons relied on by Petitioners for the grant of the Writ are therefore not by any means that Petitioners are simply dissatisfied with the decision of the Court of Appeals.

Respondent's Statement.

Respondent's Brief states (p. 3):

> "The only thing which the patentee Wright (II, 793, I, 26) did to this conventional construction was to insert in the window opening, forwardly of the vertically slidable window pane, a pivoted wing or panel secured to the front door pillar so it might pivot about its front edge."

But such was not the finding of the Court of Appeals quoted from in the Petition (p. 12).

The fact that the identical **illustrative embodiment** of the

Wright patent was improved by Fisher of General Motors and used, cannot affect the patent in question here; for, as this Court said in Smith v. Snow, 294 U. S. 1, 11:

> "We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use, since the claims of the patent, not its specifications, measure the invention."

Here the District Court specifically found no patentable distinction between the Fisher and Wright patent embodiments (R. 765-7); that the Wright patent is "not limited to the hinging of the front panel at the front edge," and that "the construction of the Fisher patent includes that of the Wright patent" (R. 760). That appeared also to be the view of the Court of Appeals (Dec. p. 3). However, even the Wright patent embodiment was found useful and has gone into use in England in low and high priced cars (R. 228-230).

The price paid to Wright, $11,750.00 (R. 761), was certainly not "nominal" to the inventor Wright. Nor do we here simply rely upon claims added by Reissue, for here, as before the Court of Appeals, we rely on claim 8, which was in the original patent, and claim 19 which is really specific.

The development in this art which Respondent's Brief seeks to trace (p. 6), confuses that which happened after Wright filed with what happened before. The District Court's findings (12 and 16, R. 761 and 763) were that there was **no commercial use** of Wright's invention at all, not even of a wind wing, before Wright filed.

Respondent's Argument.

The argument (pp. 7-11) reference the Fennerty patent, the publication of a California Top in "Autobody" and the Stafford Car, utterly fails to take into account, that none of these have the **structure** of the Wright patent, and can, therefore, not display the **principle or mode of operation** of the Wright patent, nor secure its **result.** Respondent's argument is silent on the admissions of their own witness Brush, that none of these prior art instances had the Wright structure; (see the Blackboard exhibits 44, 45 and 49, R. 941, 943, 953, and Brush's testimony, R. 351-4 and 471). See, also, our discussion Petition pp. 9-11.

The question to and the answer of Professor Thompson (not a professional patent expert) quoted in Respondent's Brief (pp. 7-8) was "about the **operation** of the structure," as distinguished from a **structure to secure a mode of operation.** Here the prior art admittedly lacks the Wright structure and must therefore lack his mode of operation. So, also, the question to and the answer of Mr. Arnold (not a professional patent expert) quoted from in Respondent's Brief (p. 7) has reference to the **operation** of the **panels** in the Wright structure and not to the advantages secured in locating those panels in a **Wright door,** as distinguished from locating them on the **body in front of the door,** as in the California Top publication and the Stafford Car, the comparative utility of which Arnold later pointed out (R. 693-4); see our discussion (Petition pp. 8-9).

Respondent's argument before this court overlooks the fact that R. S. 4886, as construed by this court, must be construed in connection with R. S. 4888, and that a prior patent, publication, or use must possess qualifications as to definiteness of disclosure of structures and prin-

ciple, in order to strike down a presumptively valid patent. The Court of Appeals, as well as the District Court, fell into the same error. This has been shown in our Petition and Brief, particularly at pages 9, 10, 12, 25, 26 and 28.

Respectfully submitted,

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October 15, 1941.